

REMARKS

I. Status of the Claims

Claims 1, 2, 4-46, and 49-92 are pending in this application. Claims 3, 47, and 48 are canceled herein without prejudice or disclaimer. Claim 1 is amended herein to recite that the human keratin materials have a tone height of less than or equal to 6. Support for this amendment can be found in original claim 3. Claim 4 is amended to depend from claim 1. Claim 23 is amended to delete the recitation of “azo, azomethine, and methane monocationic fluorescent dyes.”

Claims 49, 88, 89, 91, and 92 are amended herein to recite that the at least one fluorescent dye is not chosen from azomethine fluorescent dyes. Claims 57 and 58 are also amended herein to delete the recitation of azomethine dyes. Method claim 93 is new and recites that the at least one fluorescent dye is not chosen from azomethine fluorescent dyes. Support for these amendments can be found at least in the specification on page 10, paragraph [047], which states that “[i]n one embodiment, the composition does not comprise, as the at least one fluorescent dye, a compound chosen from azo, azomethine, and methine monocationic heterocyclic fluorescent dyes.” Applicants further submit that this proviso is fully supported as described below and, therefore, that no new matter has been added by this amendment.

Applicants believe that the proviso in claims 49, 88, 89, and 91-93 is fully supported by the specification as filed. Applicants assert that they are simply claiming less than the full scope of their disclosure – a legitimate procedure for inventors entitled to decide the bounds of protection they seek. See, e.g., *In re Johnson*, 558 F.2d 1008 (C.C.P.A. 1977). The court in *Johnson* found that a “broad and complete generic

disclosure, coupled with extensive examples fully supportive of the limited genus now claimed" supported the exclusion of specific compounds. 558 F.2d at 1018. In *Johnson*, a broad class of precursor compounds was recited including 26 specific examples. An added proviso excluded certain compounds to provide a limited genus, where 14 examples fell within the scope of the limited genus. The court in *Johnson* held that the written description supported the broader genus, and "having described the whole, necessarily described the part remaining." *Id.* at 1019.

Ex parte Grasselli, 231 USPQ 393, 394 (Bd. Pat. App. 1983) is often cited by the USPTO in response to an amendment limiting the scope of a claim in view of prior art. In *Grasselli*, the claim at issue related to a process for the ammoxidation of propane or isobutane comprising using a catalyst described in a certain formula. In response to an Office Action, the Applicant amended a claim to recite that the catalyst was free of uranium and the combination of vanadium and phosphorus. The claimed formula, however, did not originally cover uranium. Thus, the Applicant sought to exclude uranium from the catalyst, but uranium was not a species falling within the genus of the recited catalytic formula. The Board held that there was no written description for the negative limitation.

The *Grasselli* facts sharply contrast with the present facts. In *Grasselli*, uranium was never covered by the original genus. In the present case, Applicants seek nothing more than to proviso out a particular species of fluorescent dye (azomethine fluorescent dyes), which falls within the original genus of compounds defined. Thus, *Grasselli* is inapplicable to the present application.

Moreover, adequate written description, particularly with respect to provisos, does not require literal support for the claimed invention. *In re Wertheim*, 191 USPQ 90, 98 (CCPA 1976). Applicants assert that they fall directly within the rationale of *Wertheim*, which held that to rule that the entire genus is not patentable because the applicant erroneously thought he was the first to invent the genus of compounds would exalt form over substance. *Id.* at 97. The present situation, like that in *Wertheim* (and in contrast to the situation in *Grasselli*), does not involve a new concept. Rather, the present situation involves a member of the originally claimed genus that is simply being excised. *Wertheim* approved that approach, and the Office has no reason to treat Applicants any differently.

As established above, Applicants have the right to claim less than the full scope of their disclosure, and thus can exclude azomethine fluorescent dyes. As such, Applicants assert that the proposed proviso in claims 49, 88, 89, and 91-93 has sufficient support in the specification.

II. Rejections Under 35 U.S.C. § 103

Claims 1-8, 10-24, 28-34, 36-58, 61-62, 64-76, and 78-92 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0054206 to Matsunaga et al. ("Matsunaga") in view of U.S. Patent Application Publication No. 2001/0023514 to Cottard et al. ("Cottard"). Claims 9 and 63 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Matsunaga* in view of *Cottard* and further in view of U.S. Patent No. 6,156,077 to Shibata et al. ("Shibata"). Claims 25-27 and 59-60 and 63 are rejected under 35 U.S.C. § 103(a) as being

unpatentable over *Matsunaga* in view of *Cottard* and further in view of U.S. Patent No. 6,436,153 to Rondeau ("Rondeau"). Applicants assert that these rejections are obviated in view of the claims as amended.

To prove a *prima facie* case of obviousness, the Office must show that the cited references would have provided to the skilled artisan some suggestion or motivation to combine or modify their teachings in an effort to achieve all of the limitations of the claimed invention, with a reasonable expectation of success. See MPEP § 2143. For at least the reasons discussed below, none of the references relied upon by the Office contain any such suggestion or motivation or the requisite reasonable expectation of success.

Claims 1, 2, and 4-46

Claims 1, 2, and 4-46, as amended and as represented by independent claim 1, recite a method for dyeing human keratin materials having a tone height of less than or equal to 6 with a lightening effect comprising applying to the human keratin materials a composition comprising, in a cosmetically acceptable medium, at least one fluorescent dye that is soluble in the medium and at least one surfactant chosen from amphoteric and nonionic surfactants.

Matsunaga describes hair dye compositions containing an azomethine dye as direct dye. See abstract. However, *Matsunaga* does not teach or suggest a process for dyeing hair having a tone height of less than or equal to 6. Accordingly, as applied to claims 1, 2, and 4-46, as amended, *Matsunaga* does not teach or suggest each and

every element of the pending claims, and thus, *Matsunaga* alone cannot form a proper basis for an obviousness rejection.

Matsunaga is the sole reference relied upon by the Examiner which allegedly discloses fluorescent dyes in hair dye compositions. None of the secondary references (*Cottard*, *Shibata*, and *Rondeau*) disclose or suggest hair dye compositions comprising fluorescent dyes or a method for dyeing human keratin materials having a tone height of less than or equal to 6 comprising applying such fluorescent dyes to the keratin materials. Thus, any combination of these references also necessarily fails to teach or suggest a method for dyeing human keratin materials having a tone height of less than or equal to 6 with a lightening effect comprising applying at least one fluorescent dye to the keratin materials. Accordingly, in view of the above arguments and claim amendments, Applicants assert that presently pending claims 1, 2, and 4-46 are patentably distinct over the prior art and respectfully request that the Examiner withdraw all rejections and allow the claims.

Claims 49- 92

Claims 49-92, as amended and as represented by independent claims 49, 88, 89, 91, and 92, recite a composition comprising, in a cosmetically acceptable medium, at least one fluorescent dye that is soluble in the medium and at least one surfactant chosen from amphoteric and nonionic surfactants, wherein the at least one fluorescent dye is not chosen from azomethine fluorescent dyes.

In contrast, *Matsunaga* describes hair dye compositions containing an azomethine dye as direct dye. See abstract. *Matsunaga* suggests that the hair dye

composition may further comprise nonionic and amphoteric surfactants. See page 3, paragraph [0025]. *Matsunaga* does not disclose or suggest hair dye compositions comprising fluorescent dyes other than the particular described azomethine dyes. Thus, *Matsunaga* fails to teach or suggest a composition comprising at least one fluorescent dye with at least one amphoteric or nonionic surfactant wherein the at least one fluorescent dye is not chosen from azomethine fluorescent dyes. To the contrary, azomethine dyes are a required part of *Matsunaga*'s invention.

Matsunaga is the sole reference relied upon by the Examiner which allegedly discloses fluorescent dyes in hair dye compositions. None of the secondary references (*Cottard*, *Shibata*, and *Rondeau*) disclose or suggest hair dye compositions comprising fluorescent dyes. Thus, any combination of these references also necessarily fails to teach or suggest a composition comprising at least one fluorescent dye with at least one amphoteric or nonionic surfactant wherein the at least one fluorescent dye is not chosen from azomethine fluorescent dyes. Accordingly, in view of the above arguments and claim amendments, Applicants assert that presently pending claims 49-92 are patentably distinct over the prior art and respectfully request that the Examiner withdraw all rejections and allow the claims.

New Claim 93

For the reasons given above with regard to claims 49-92, Applicants assert that new claim 93 is also patentable over the cited prior art. Thus, Applicants respectfully request that the Examiner allow new claim 93.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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